

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-4 and 6-21 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,758,087 to *Aaker* and rejected claim 5 under 35 U.S.C. § 103(a) as unpatentable over *Aaker* in view of U.S. Patent No. 5,765,154 to *Horikiri*.

By this amendment, Applicants have amended claims 1, 4, 6, 14, and 18. No new matter has been added. Claims 3, 16, and 20 are cancelled without prejudice or disclaimer. Claim 22 is new. Claims 1, 2, 4-15, 17-19, 21, and 22 are now pending.

35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1, 2, 4, 6-15, 17-19 and 21 under 35 U.S.C. § 102(b) as being anticipated by *Aaker*. Rejections with respect to cancelled claims 3, 16, and 20 are moot. In order to properly establish that *Aaker* anticipates Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. See M.P.E.P. § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Aaker does not disclose each and every element of Applicants' claimed invention. Amended claim 1 recites a combination of elements including, for example,

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

“pre-render one or more of the possible user interface states to generate one or more possible user interface appearances while the user interface is in the current user interface state.” The Examiner alleges that *Aaker* anticipates “storing the one or more possible user interface appearance for later use” when *Aaker* discloses “transfer predictions are prepared for the identified embedded files.” Final Office Action, page 4. However, *Aaker* does not anticipate amended claim 1.

No portion of *Aaker* describes “pre-render[ing] one or more of the possible user interface states to generate one or more possible user interface appearances while the user interface is in the current user interface state,” as recited in claim 1. *Aaker* prepares “a group of predicted responses” (Column 6, lines 5-6) and prepares “a file transfer prediction for a current document” (Column 6, lines 54-57) but neither of these disclosures constitute “pre-rendering,” as claimed. When “preparing a group of predicted responses,” *Aaker* “identifies” “files” for “transfer,” “reads” “file blocks,” and prepares “protocol transmission information.” Column 6, lines 37-53. None of these activities constitutes “pre-rendering” as recited in claim 1.

Even assuming, *arguendo*, that the files to be transferred could be “pre-rendered” files, which Applicants dispute for the reasons given above, *Aaker* fails to teach “pre-render[ing] one or more of the possible user interface states to generate one or more possible user interface appearances while the user interface is in the current user interface state,” as recited in claim 1. *emphasis added*.

Therefore, no portion of *Aaker*, constitutes the claimed “pre-render[ing] one or more of the possible user interface states to generate one or more possible user interface appearances while the user interface is in the current user interface state.” Accordingly, *Aaker* fails to anticipate claim 1.

Because *Aaker* does not disclose each and every element recited by amended claim 1, *Aaker* cannot anticipate this claim. Claim 1 is allowable over the art of record. Independent claims 14 and 18, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 14 and 18 are therefore allowable for at least the reasons presented above with respect to claim 1. Claims 2, 4 and 6-13, 15, 17, 19, and 21 are also allowable at least due to their respective dependence from claims 1, 14, and 18. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 2, 4, 6-15, 17-19, and 21 under 35 U.S.C. § 102(b) for at least the above reasons, and allow claims 1, 2, 4, 6-15, 17-19, 21, and 22.

35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 5 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness “based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. A *prima facie* case of obviousness has not been established because, among other things, the prior art does not render obvious each and every element of Applicants’ claims.

Dependent claim 5 includes all of the elements of independent claim 1, including, for example a “pre-render[ing] one or more of the possible user interface states to generate one or more possible user interface appearances while the user interface is in the current user interface state.” As set forth above, *Aaker* fails to teach, suggest, or render obvious all of the elements required by claim 1.

The Examiner alleges that *Horikiri* discloses “hypertext documents . . . well known as HTML (Hypertext Markup Language).” Final Office Action, page 11. Even assuming that this allegation is true, which Applicants do not concede, *Horikiri* fails to cure the deficiencies of *Aaker* discussed above. That is, *Horikiri* does not compensate for the deficiencies of *Aaker* because *Horikiri* does not render obvious “pre-render[ing] one or more of the possible user interface states to generate one or more possible user interface appearances while the user interface is in the current user interface state,” as recited in claim 1, and required by claim 5.

Accordingly, the prior art fails to establish a *prima facie* case of obviousness with respect to claim 5. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claim 5 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Applicants also request an Examiner’s interview. Applicants ask that the Examiner contact the undersigned to schedule an interview at the Examiner’s convenience.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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